PRE-APPEAL BRIEF REQUEST FOR REVIEW	Docket Number Q79816	
Mail Stop AF Commissioner for Patents P.O. Box 1450 Alexandria, VA 22313-1450	Application Number 10/781/628	Filed February 20, 2004
	First Named Inventor Rakashi MURAI	
	Art Unit 2617	Examiner Willie J. Daniel, Jr.

WASHINGTON OFFICE
23373
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Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal

The review is requested for the reasons(s) stated on the attached sheet(s).
      Note: No more than five (5) pages may be provided.

☑ I am an attorney or agent of record.
    Registration number   28,703

/DJCushing/
_____
Signature

David J. Cushing
_____
Typed or printed name

(202) 293-7060
_____
Telephone number

March 1, 2010
_____
Date

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of   Docket No: Q79816

Takashi MURAI

Appln. No.: 10/781,628   Group Art Unit: 2617

Confirmation No.: 4140   Examiner: Willie J. Daniel Jr.

Filed: February 20, 2004

For: METHOD FOR DISTRIBUTING VIDEO INFORMATION TO MOBILE PHONE
        BASED ON PUSH TECHNOLOGY

<u>**PRE-APPEAL BRIEF REQUEST FOR REVIEW**</u>

MAIL STOP AF - PATENTS
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

Pursuant to the Pre-Appeal Brief Conference Pilot Program, and further to the

Examiner's Final Office Action dated August 28, 2009, Applicant files this Pre-Appeal Brief

Request for Review. This Request is also accompanied by the filing of a Notice of Appeal.

Claims 1-3, 7 and 9 are all the claims pending in the application.

It is noted that a double patenting rejection has not been stated but has been suggested as

a possible future action by the examiner in paragraphs 4-5 of the Office action. To the extent

that issue is relevant for this panel review, it is well recognized that even slight differences in

scope justify different claims. The issue addressed in MPEP 706.03(k) is where there is no

difference in scope. Note that the language of MPEP does not suggest a duplicate claim problem

were there are only minor differences in claim language, but quite pointedly suggests the

problem exists only when the language differences are so slight "that they both cover the same

thing." Claims 2 and 3 do not cover the same thing. Set forth below is claim 3 with underlining

to show the language of claim 3 not found in claim 2. Claim 3 requires that the distributed video

information be information about an area, and requires detection that the mobile phone is in fact in that area, and requires detection of radio channel traffic at a time when the mobile is in that area. Claim 2 does not require these features, and is therefore of different scope.

> 3. (previously presented) A method for distributing video information to a mobile phone from a video contents server, based on push technology, said video contents server configured to store therein the video information to be distributed, under control of a user management server which controls user registration and video information distribution, comprising:
>
> registering a user request for a video information distribution service about an area to the user management server in advance;
>
> detecting that the mobile phone exists in a specific area;
>
> detecting traffic of a radio channel connected to the mobile phone at a time when existence of the mobile phone in the specific area has been detected; and
>
> when the detected traffic is lower than a threshold, distributing video information about the specific area from the video contents server to the mobile phone based on said push technology;
>
> when said video information is distributed from the video contents server to the mobile phone while a user is using the mobile phone, causing the mobile phone to save the distributed video information;
>
> when the video information is distributed from the video contents server to the mobile phone while the user is not using the mobile phone, causing the mobile phone to display the distributed video information for only a time period, and thereafter causing the mobile phone to stop displaying the video information while the user is still not using the mobile phone and save the remaining video information distributed after the time period has elapsed; and
>
> causing the mobile phone to display the saved video information on the basis of a user's instruction.

In the only stated rejection, the examiner has rejected all of claims 1-3, 7 and 9 under 35 USC 103(a) as unpatentable over Ayres in view of Trossen, Cohn, Kuramitsu and Shiotsu.

The present invention is directed to the distribution of video information to a mobile phone. According to the invention as defined in claim 1, the user request for video information

is registered ahead of time, and at an appropriate later time the video information is "pushed" to the mobile phone. If the information has not already been provided to the mobile phone, and if the phone is not otherwise in use, the video is displayed in real time, and if the mobile phone is already in use, the video information is not displayed in real time but is instead stored for later display. According to the last paragraph of claim 1, if the video is distributed while the phone is not in use, the video is displayed only for a period of time, and thereafter while the user is still not using the mobile phone, the video display is stopped and the video information is saved until the user later instructs the mobile phone to display the stored video information.

As pointed out in the response filed May 22, 2009,

1. Kurimatsu does not teach that the later reproduction of stored video information is in response to a user instruction, and

2. Kurimatsu does not teach, even when the user is not on a call, displaying the video only for some time period, and thereafter storing the remainder and reproducing it only on user command.

The claims were at that time amended to clarify that the mobile phone stops displaying the video information while the user is still not using the mobile phone, i.e., it is the elapse of the time period which triggers the stopping of the video, not the usage of the phone, which differs from Kurimatsu where the video display is only interrupted when the user begins a voice call.

Applicant also noted that, with automatic reproduction triggered by the end of the call, Kurimatsu would not even be capable of stopping the video display while the user is still not using the mobile phone.

The examiner has now relied additionally on Shiotsu et al (USP 7,142,204) to teach the missing features. Applicant believes the combination proposed by the examiner would not have been obvious.

In general, it is submitted that the examiner is picking and choosing amongst the teachings of five different references in an effort to satisfy the claim language. The proposed

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combination of references would have made no sense absent the teaching of the present application.

In his rejection, the examiner first relies on Ayers to teach the push distribution of video information to a registered user, then relies on Trossen to teach the detection of traffic conditions and sending the video content only when the traffic is below a threshold. The examiner then relies on Cohn to teach the sending of video to the user when the phone is not in use. The examiner then relies on Kuramitsu to teach the display of received video information for a period of time and thereafter storing the remaining video information. Kurimatsu teaches this in the context of a call received during the video transmission, so that Kurimatsu would interrupt the video display until the call is completed. Now the examiner relies on Shiotsu et al to teach that the video display is interrupted for power conservation purposes.

Before even getting to the teaching of Shiotsu, the combination proposed by the examiner has the video sent during a low traffic period and only when the phone is not being used. To teach sending when the phone is not in use, the examiner relies on the reconnection process of Cohn, i.e., a phone is not being used when it is trying to reconnect. But the paragraph of applicant's claim reciting the sending of video information when the phone is not in use reads:

> when the video information is distributed from the video contents server to the mobile phone while the user is not using the mobile phone, causing the mobile phone to display the distributed video information for only a time period, and thereafter causing the mobile phone to stop displaying the video information while the user is still not using the mobile phone and save the remaining video information distributed after the time period has elapsed; and

In Cohn, when the phone has lost its connection, it cannot display the video information being sent to the mobile phone. Once the connection is restored, then the phone is no longer "not in use" and whatever happens is not relevant to this claim language.

The teaching in Kuramitsu relied on by the examiner to teach causing the phone to display the video information only for a short period of time and thereafter causing the phone to stop displaying is the feature of Kuramitsu where the video display is stopped when an incoming

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call is detected. But once the incoming call occurs, the user is using the mobile phone, so this aspect of Kuramitsu cannot possibly be considered to teach the claimed feature of operation when the user is not using the phone.

Shiotsu teaches cutting short a video display for power conservation purposes. While this may make sense in general, the combination proposed by the examiner has (i) the video information sent about specific area sent to the user while the use is in that specific area, but (ii) the user has lost a connection and is being sent video information during reconnect, (ii) this video sent during reconnect is (according to the claim language) not sent if the traffic level is too high (which would mean that if the traffic level is high the system will not attempt to reconnect?) and (iv) if an incoming call comes in while the system is trying to reconnect the first call, the display of video information will be suspended (according to Kuramitsu). But no incoming call will be ever be forwarded to the user during a time when the system is trying to reconnect a previous call, so this last feature makes no sense at all. And finally, when the system is in the midst of reconnecting one call and trying to receive another, the display will be shut down for power conservation purposes. Again, this just makes no sense, and makes it very clear that the motivation for combining the teachings of the references in the manner proposed by the examiner is a strained attempt to satisfy the claim language by picking and choosing features of the various references using the claim as a road map.

It is submitted that the claimed invention would not have resulted from any obvious combination of the teachings of the prior are, but is only arrived at with the help of hindsight in a specific attempt to select features from various references that make no sense to combine.

Respectfully submitted,

/DJCushing/_____

SUGHRUE MION, PLLC
Telephone: (202) 293-7060
Facsimile: (202) 293-7860

David J. Cushing
Registration No. 28,703

WASHINGTON OFFICE

23373

CUSTOMER NUMBER

Date: March 1, 2010